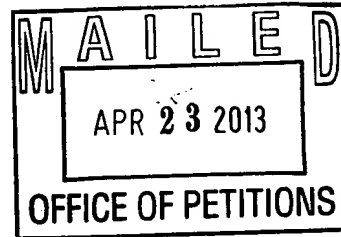




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In re Patent No. 8,166,384
Issued: April 24, 2012
Application No. 09/594,054
Filed: June 14, 2000
Attorney Docket No. 07844-0427001 /
P391

: DECISION ON REQUEST
: FOR RECONSIDERATION OF
: PATENT TERM ADJUSTMENT
: and
: NOTICE OF INTENT TO ISSUE
: CERTIFICATE OF CORRECTION

This is in response to the REQUEST FOR RECONSIDERATION OF DECISION REGARDING PATENT TERM ADJUSTMENT, filed December 31, 2012, requesting that the patent term adjustment in the above-identified patent be corrected to 3875 days. This request is timely filed pursuant to the decision on petition mailed November 1, 2012, and is limited to reconsideration of the interpretation of appellate review applied to the above-identified patent.

The petition to correct the patent term adjustment indicated on the above-identified patent to indicate that the term of the above-identified patent is extended or adjusted by four thousand fifty-two (4,052) days is **GRANTED**.

The patent issued with a revised patent term adjustment of 2,957 days. On June 25, 2012, patentee timely filed the initial request for reconsideration of patent term adjustment including a request to waive the provisions of 37 CFR 1.703(b)(4) based on the proposed rule. In its November 1, 2012 decision, the Office refused to waive 37 CFR 1.704(b)(4) based on the proposed rule. The patent term adjustment continued to not include the periods consumed by appellate review under 35 U.S.C. 154(b)(1)(B)(ii) beginning on July 7, 2004 and December 22, 2005, the day the notices of appeal were filed.

Pursuant to the Office's revised interpretation of appellate review, the reduction of B delay days pursuant to 35 U.S.C. 154(b)(1)(B)(ii) and new 37 CFR 1.703(b)(4) is being removed where jurisdiction over the application did not pass to the Board under 37 CFR 41.35(a). *Revision of Patent Term Adjustment Provisions Relating to Appellate Review*, 77 FR 49354 (August 16, 2012).

In view thereof, the over 3 year "B delay" is being calculated, pursuant to the Office's revised interpretation of appellate review. There is no reduction in association with the notice of appeal filed July 4, 2004 pursuant to 35 U.S.C. 154(b)(1)(B)(ii) and new 37 CFR 1.703(b)(4) because jurisdiction over the application did not pass to the Board

under 37 CFR 41.35(a) during this time. *Revision of Patent Term Adjustment Provisions Relating to Appellate Review*, 77 FR 49354 (August 16, 2012). However, jurisdiction passed to the Board on July 18, 2006 with the filing of the reply brief and ended on November 2, 2011, the date the decision was rendered by the Board. Thus, 1934 days are consumed by appellate review under the new rule.

Thus, the B delay is $3237 - 1934 = 1303$ days.

However, considering the period excluded for the successful appellate review, the period of overlap between A and B is 0 days.

Applicant is advised further that the entry of 1061 days of A delay is incorrect because the Examiner's Answer was mailed May 18, 2006, within 4 months of the Appeal Brief filed February 22, 2006. Applicant is not therefore entitled to additional time pursuant to 37 CFR 1.703(a)(2) for the supplemental examiner's answer. In view thereof, 1061 days of examination delay is being removed. Total A delay therefore is 846 days.

With respect to C delay, as jurisdiction passed to the board on July 18, 2006, with the filing of a reply brief and ended on November 2, 2011, with the issuance of the board decision, the C delay is 1934 days, not 2142 days.

Applicant delay of 31 days is not in dispute.

In view thereof, the correct patent term adjustment is: $[A = 846 \text{ days}] + [B = 1303 \text{ days}] + [C = 1934] - [\text{overlap} = 0 \text{ days}] - [\text{applicant delay} = 31] = 4,052$ days.

It is noted that the revisions to 37 CFR 1.704(c)(11) apply only to applications in which the notice of appeal was filed on or after September 17, 2012.

The application is being forwarded to the Certificates of Branch for issuance of a certificate of correction. The Office will issue a certificate of correction indicating that the term of the above-identified patent is extended or adjusted by **four thousand fifty-two (4,052)** days.

Telephone inquiries specific to this decision should be directed to the undersigned at (571) 272-3212.

/Patricia Faison-Ball/

Patricia Faison-Ball
Senior Petitions Attorney
Office of Petitions

DRAFT
UNITED STATES PATENT AND TRADEMARK OFFICE
CERTIFICATE OF CORRECTION

PATENT : 8,166,384 B1

DATED : April 24, 2012

INVENTOR(S) : Michael Kaplan

It is certified that error appears in the above-identified patent and that said Letters Patent is hereby corrected as shown below:

On the cover page,

[*] Notice: Subject to any disclaimer, the term of this patent is extended or adjusted under 35 USC 154(b) by (2957) days

Delete the phrase "by 2957 days" and insert – by 4052 days--